



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,494	02/07/2006	Julian Dakowski	BOUL0017	9341
26290 7590 03/17/2010 PATTERSON & SHERIDAN, I.L.P. 3040 POST OAK BOULEVARD SUITE 1500 HOUSTON, TX 77056				
EXAMINER				
SIVANESAN, SIVILINGAM				
ART UNIT		PAPER NUMBER		
2121				
MAIL DATE		DELIVERY MODE		
03/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,494

Applicant(s)

DAKOWSKI, JULIAN

Examiner

SIVALINGAM SIVANESAN

Art Unit

2121

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-17, 20, and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-17, 20, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/07/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :02/07/06, 11/01/07, 02/12/08,07/07/08,01/13/09,02/13/09.

DETAILED ACTION

1. This office action is responsive to an AMENDMENT dated 12/21/2009 for the patent application 10/567494.

Status of Claims

2. Claims 1-17, 20 -22 and 26-33 were rejected in the last Office Action dated June 22nd 2009.
3. Claims 1-3, 5 -17, 20 and 22 are now presented for examination in this Office Action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 8-11, 13-14, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/080135 A1.
3. Nakayama et al. (US 2004/0109987 A1; Hereinafter referred as Nakayama) is the English-language equivalent of WO 02/080135 A1, and will be the reference cited in the rejection below.

4. Regarding claim 1, Nakayama discloses a process for manufacturing an article comprising a substrate and an overlay that is at least one of translucent, semi-transparent or transparent, the substrate having a contoured surface and the overlay being provided over at least a portion of said contoured surface, the process comprising:

(a) using a computer system to generate data corresponding to a three-dimensional image([0073];Fig.3-4)

(b) using the generated data to control an apparatus to form at least a portion of a mould for defining the contoured surface of the substrate(fig.3-4);

(c) using said mould to form at least the contoured surface of the substrate (Fig. 3-4; claim 6-10) and

(d) providing the overlay over said at least a portion of the contoured surface (Fig.3-4; claim 6-10)

5. Regarding claim 2, Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process as claimed in claim 1, wherein said substrate is formed by at least one of: moulding, pressing or embossing([0020];claim 9).

6. Regarding claim 3 , Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process, wherein at least a portion of an outer surface of the overlay is substantially planer (Fig. 1).

7. Regarding claim 5, Nakayama discloses everything as applied above (see claim 1 and claim 4). In addition Nakayama discloses a process as claimed in claim 1,

wherein the overlay is initially a liquid medium and the process includes providing the liquid medium on the contoured surface ([0019]).

8. Regarding claim 8, Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process further comprising supplying data corresponding to a two-dimensional image to the computer system and generating the data corresponding to the three-dimensional image from said two-dimensional image data ([0073]).

9. Regarding claim 9, Nakayama discloses everything as applied above (see claim 1 and claim 8). In addition Nakayama discloses a process wherein the two-dimensional image data corresponds to a photographic image or a picture ([0087]).

10. Regarding claim 10, Nakayama discloses everything as applied above (see claim 1 and claim 8). In addition Nakayama discloses a process as claimed in claim 8, wherein the two-dimensional image data supplied to the computer system corresponds to at least one of a colour photographic image or picture and the process further comprises converting at least one of the two-dimensional or three-dimensional image data to monochrome greyscale image data([0093] - [0094]; Fig. 7).

11. Regarding claim 11, Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process as claimed in claim 1, further comprising coating the contoured surface with a reflective material ([0008]; [0015]; [0068]);

12. Regarding claim 13, Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process as claimed I , wherein the substrate is made of clay, ceramic, glass, metal, resin or plastic([0067]).

13. Regarding claim 14, Nakayama discloses everything as applied above (see claim 1). In addition Nakayama discloses a process as claimed I, wherein the overlay is a glaze, glass, resin, enamel or plastic([0018]).

14. Regarding claim 20, Nakayama discloses a process for manufacturing an article comprising a substrate and a member that is at least one of translucent, semi-transparent or transparent, the member having a contoured surface and the substrate being provided over at least a portion of said contoured surface, the process comprising: (a) using a computer system to generate data corresponding to a three-dimensional image([0073];Fig.3-4);

(b) using the generated data to control an apparatus to form at least a portion of a mould for defining the contoured surface of the member(fig.3-4; [0067]);

(c) using said mould to form at least the contoured surface of the member([0067]); and

(d) providing the substrate over said at least a portion of the contoured surface([0067]).

15. Regarding claim 22, Nakayama discloses everything as applied above (see claim 20). In addition Nakayama discloses a process as claimed in claim 20, wherein the substrate is coating that is at least one of reflective or mirrored ([0008]; [0015]; [0068]).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama as applied to claims 1 and 26 above, and further in view of Official Notice.

18. Regarding claim 6, Nakayama discloses everything as applied above (see claim 1 and claim 5). Nakayama does not disclose a process, wherein the overlay is initially a solid medium and the process includes providing the solid medium on the contoured surface and converting it to a liquid.

However, examiner takes Official Notice that this feature is well known in the art and it is the general knowledge of a person of ordinary skill in the art. A person of ordinary skill would have been motivated to combine this feature with the Nakayama's invention for the purpose of using solid medium to facilitate the overlaying on the contoured surface.

19. Regarding claim 7, Nakayama discloses everything as applied above (see claim 1 and claim 5-6). Nakayama does not disclose a process, wherein the solid medium is converted to a liquid by applying heat. However, examiner takes Official Notice that this feature is well known in the art and it is the general knowledge of a person of ordinary skill in the art. A person of ordinary skill would have been motivated to combine this feature with the Nakayama's invention for the purpose of using solid medium to pour overlay on the contoured surface.

20. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama as applied to claim 1 above, and further in view of Sorm Michel (WO 00/56558; Hereinafter referred as Sorm, provided by Applicant).

21. Regarding claim 12, Nakayama discloses everything as applied above (see claim 1 and claim 5-6). Nakayama does not disclose a process, wherein the article is a tile. However Sorm, in an analogous art, discloses a process in which the article is tile. It would have been obvious that a person of ordinary skill in the art would have combined this feature with the invention of Nakayama to increase the appearance of the tile.

22. Claims 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama as applied to claim 1 above, and further in view of Dufort (EP 1318003 A1, provided by Applicant).

23. Regarding claim 15, Nakayama discloses everything as applied above (see claim 1). Nakayama does not disclose a process, wherein the article is a bar of soap and at least one of the substrate and the overlay is made of soap. However Dufort discloses that a process wherein the article is a bar of soap and at least one of the substrate and the overlay is made of soap ([0017]; claim15). A person of ordinary skill would have

combined this feature with the invention of Nakayama in order to enhance the appearance of the soap.

24. Regarding claim 16, Nakayama discloses everything as applied above (see claim 1). Nakayama does not disclose a process wherein the article is a foodstuff and the substrate and the overlay are edible. However Dufort discloses that a process which the article is formed from material such as candy or chocolate ([0017]; claim14). A person of ordinary skill would have combined this feature with the invention of Nakayama in order to enhance the look of the candy.

25. Regarding claim 17, Nakayama discloses everything as applied above (see claim 1). Nakayama does not disclose a process wherein said apparatus is a computer numerically controlled engraving or milling machine. However Dufort discloses a process in which the apparatus is a numerically controlled milling machine ([0036]). A person of ordinary skill would have included this feature with the Nakayama's invention in order to use the intensity data to machine the mould for further enhancements.

Response to Arguments

Applicant's amendments and arguments filed 05/15/2009 have been fully considered. The amendments does not overcome the original art rejection and the arguments are not persuasive. The following are the Examiner's observations in regard thereto.

Applicant Argues:

Claims Rejections - 35 U.S.C. § 102

Claims 1-5, 8-11, 13-14, 20-22, 26 and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nakayama et al ~IVO 02/080135, reference to US publication 2004/0109987). Applicant has canceled claims 4, 21, 26, 28, and 29. Applicant respectfully traverses the rejection with respect to the remainder of the claims.

The Examiner asserts that Nakayama et al. teaches a process for manufacturing an article comprising: (a) using a computer system to generate data corresponding to a three-dimensional image ([0073]; Fig. 3-4), (b) using the generated data to control an apparatus to form at least a portion of a mould for defining a contoured surface of the substrate (Fig. 3-4), using said mould to form at least the contoured surface of the substrate (Fig. 3-4; claim 6-10), and (d) providing the overlay over said at least a portion of the contoured surface (Fig. 3-4; claim 6-10). Applicant respectfully submits that the Examiner errs in this assertion.

Nakayama et al teaches a procedure for producing an article using a production

management computer ([0072]; Fig. 4). Nakayama et al teaches that three-dimensional geometric data including image information is input into the production management computer. The production management computer then converts the image information into height information. Next, a base model is produced based on the height information ([0073]; Fig. 4). Finally, a translucent film is applied to the surface of the base model, allowed to solidify, and then finished to a smooth surface ([0074], Fig. 4). Nakayama et al does not disclose that the base model could be used as a mould for making an object that is later coated with an overlay. Thus, Nakayama et al fails to teach using computer generated data to control an apparatus to form at least a portion of a mould for defining a contoured surface of a substrate and using the mould to form at least the contoured surface of the substrate as asserted by the Examiner.

Therefore, Nakayama et al fails to teach, show, or suggest a process for manufacturing an article comprising a substrate and an overlay that is at least one of translucent, semi-transparent or transparent, the substrate having a contoured surface and the overlay being provided over at least a portion of said contoured surface, the process comprising (a) using a computer system to generate data corresponding to a three-dimensional image, (b) using the generated data to control an apparatus to form at least a portion of a mould for defining the contoured surface of the substrate, (c) using said mould to form at least the contoured surface of the substrate, and (d) providing the overlay over said at least a portion of the contoured surface as recited in claim 1 and claims 2-3 and 5- 17 dependent thereon. Applicant respectfully requests withdrawal of the rejection. Additionally, Nakayama et al fails to teach, show, or suggest a process for

manufacturing an article comprising a substrate and a member that is at least one of translucent, semi-transparent or transparent, the member having a contoured surface and the substrate being provided over at least a portion of said contoured surface, the process comprising (a) using a computer system to generate data corresponding to a three- dimensional image, (b) using the generated data to control an apparatus to form at least a portion of a mould for defining the contoured surface of the member, (c) using said mould to form at least the contoured surface of the member, and (d) providing the substrate over said at least a portion of the contoured surface as recited in claim 20 and claim 22 dependent thereon. Applicant respectfully requests withdrawal of the rejection.

Examiner Responds:

Examiner is not persuaded. As shown in the rejection above, the prior art anticipates all the elements of the claims 1. Nakayama et al does disclose that the base model could be used as a mould for making an object that is later coated with an overlay([0074], Fig. 4).

Furthermore, Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.(MPEP section 2113).

Claim 1 is a product-by-process claim. The product in claim 1 is the same as or obvious from the product of Nakayama (fig. 1-3). Therefore claim 1 is unpatentable.

Applicant Argues:

Claims Rejections - 35 U.S.C. § 103 as being unpatentable over Nakayama et al.

Claims 6-7 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama et al. as applied to claims 1 and 26 above, further in view of Official Notice by the Examiner. Applicant has canceled claim 27. Applicant respectfully traverses the rejection with respect to claims 6 and 7.

The deficiencies of Nakayama et al. are discussed above with respect to base claim 1. The Examiner's Official Notice with respect to claims 6 and 7 does not resolve these deficiencies. Applicant respectfully requests withdrawal of the rejection.

Examiner Responds:

Examiner is not persuaded. For the reason given above (see Examiner's response to claim 1) there are no deficiencies of Nakayama et al. with respect to base claim 1.

Applicant Argues:

Claims 12 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama et al. as applied to claim 1 above, and further in view of Sorm (WO 00/56558). Applicant has canceled claim 30. Applicant respectfully traverses the rejection with respect to claim 12.

The deficiencies of Nakayama et al. are discussed above with respect to base claim 1. Sorm teaches a ceramic tile with a d-corr caused by means of light effects obtained by passage of light through a transparent material with a system of arranged formations. Sorm fails to cure the deficiencies of Nakayama et al. with respect to base claim 1. Applicant respectfully requests withdrawal of the rejection.

Examiner Responds:

Examiner is not persuaded. Examiner is not persuaded. For the reason given above(see Examiner's response to claim 1) there is no deficiencies of Nakayama et al. with respect to base claim 1.

Applicant Argues:

Claims 15-17 and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakayama et al. as applied to claim 1 above, and further in view of Dufort (EP 1 318 003).

Applicant has canceled claims 31-33. Applicant respectfully traverses the rejection with respect to claims 15-17. The deficiencies of Nakayama et al. are discussed above with respect to base claim 1. Dufort teaches a method of forming a lithophane-like article that may be formed of confectionery product or soap by determining the intensity of different points of an original image and forming the article with a thickness at each point of the article related to the intensity of the corresponding

point of the original image. Dufort fails to cure the deficiencies of Nakayama et al. with respect to base claim 1. Applicant respectfully requests withdrawal of the rejection.

Examiner Responds:

Examiner is not persuaded. Examiner is not persuaded. For the reason given above(see Examiner's response to claim 1) there is no deficiencies of Nakayama et al. with respect to base claim 1.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIVALINGAM SIVANESAN whose telephone number is (571)270-7258. The examiner can normally be reached on 8:00 AM- 4:30 PM Daily.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 5712723819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SIVALINGAM SIVANESAN/
Examiner, Art Unit 2121

/Albert DeCady/
Supervisory Patent Examiner, Art
Unit 2121
